

## **REMARKS**

Claims 1, 6-8, 10-12 and 49-60 are currently pending in the application. Claims 2-5, 9, and 13-48 are withdrawn from consideration. New claims 50-60 have been added. Support for new claims 50 and 55 is found throughout the specification, for example at page 7, lines 3-11. Support for new claims 51 and 56 is found throughout the specification, for example at page 14, lines 8-23. Support for new claim 52 is found throughout the specification, for example at page 25, lines 21-35, and page 5, line 26 to page 6, line 13. Support for new claim 53 is found throughout the specification, for example at page 27, lines 10-25. Support for new claim 54 is found throughout the specification, for example Figs. 4, 8, 9, 11 and corresponding descriptions. Support for new claim 57 is found throughout the specification, for example at page 26, lines 16-29, and page 8, lines 15-28. Support for new claim 58 is found throughout the specification, for example at page 28, lines 6-20, and page 8, line 29 to page 9, line 4. Support for new claims 59 and 60 is found throughout the specification, for example at page 9, lines 5-17. No new matter is added. Applicant respectfully requests reconsideration of the claims currently pending in the application.

### **I. Response to restriction requirement**

The Examiner's restriction requirement in the previous office action (Paper No. 13) was based on the Examiner's assumption that no generic claims are patentable. Applicant elected, with traverse, Group 111 and Group IIIA in the previous response. The non-elected groups are withdrawn. In the event that generic claims are found to be allowable, Applicant submits that the non-elected species dependent from those generic claims should be rejoined into this application.

## II. Rejection based on 35 U.S.C. § 103(a)

On page 2 of the Office Action, claims 1, 6-8, 10-12, and 49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jansen (U.S. Patent No. 6,528,006) in view of Yamane, et al. (U.S. Patent No. 5,875,004). Applicant respectfully traverses the rejections.

With respect to claim 1, the Examiner notes that Jansen teaches a method for producing a prosthesis having at least partially cutting a material segment with a beam. See abstract. The Examiner also notes that Yamane, et. al. teaches that the cutting is controlled by a process control unit to cut the material to correspond to a target image. See col. 2, line 40 to col. 4, line 25. Accordingly, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Jansen in order to utilize a process control method in order to automatically execute a visual inspection. See Yamane, et. al. col. 1, lines 10-20.

Applicant respectfully traverses the rejection.

Jansen teaches a method of producing plastic film having a predefinable outline and/or even or uneven thickness, by machining preformed plastic film for separation and/or ablation. See abstract. The separation or ablation is done by means of a laser beam. See abstract. The synthetic resin surface is locally melted at respective laser burn spots and the melted material vaporized. See col. 2, lines 25-27.

Yamane, et. al. teach an image processing inspection apparatus for industrial use in judging the quality of products. See col. 1, lines 5-9. The apparatus has a plurality of image-processing-use image memories to store image data for use in an inspection.

See col. 2, lines 43-55. The apparatus may store the image data into one image-processing-use image memory and simultaneously execute an inspection process using another image-processing-use image memory in which the image data in the preceding time has been stored. See col. 3, lines 39-45. This is a method for quality inspection. Contrary to the Examiner's note, Yamane, et. al. does not teach that the cutting is controlled by a process control unit to cut the material to correspond to a target image. See col. 2, line 40 to col. 4, line 25.

On the other hand, the subject matter of claim 1 is related to a method of producing a prosthesis comprising at least partially cutting a material segment with a beam, wherein the cutting is controlled by a process unit to cut the material to correspond to a target image. Even though Jansen teaches partial cutting or ablation using a laser, there is no teaching or motivation in Jansen to combine its laser with a process control unit. At the same time, even though a process control unit is taught in Yamane, et. al., the unit is used for inspection and image storage, and not for controlling the cutting of a material segment, as storing and comparing for quality control does not involve cutting operations.

Three criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference, or combination of references, must teach or suggest all the claim limitations. MPEP § 2142. Applicant respectfully traverses the rejection since there is no motivation in Jansen to modify its method. Jansen deals with cutting, while

Yamane, et. al only deals with inspection. The motivation for modifying Jansen's teaching to arrive at the subject matter of claim 1 is only provided by the Applicant's invention. This is impermissible hindsight reconstruction, using the Applicant's invention as a template to provide the needed motivation. The prior teaching therefore does not render obvious the subject matter of claim 1, as the Examiner has failed to make out a prima facie case of obviousness. Without using Applicant's invention as a template, there is no motivation to combine the references as proposed by the Examiner.

Dependent claims 6-7, which are dependent from independent claim 1, were also rejected under 35 U.S.C. §103(a) as being unpatentable over Jansen in view of Yamane, et. al., in the same manner as relied on for the rejection of claim 1. Dependent claims 8, and 10-12, which are dependent from independent claim 7, were also rejected under 35 U.S.C. §103(a) as being unpatentable over Jansen in view of Yamane, et. al., in the same manner as relied on for the rejection of claim 7.

Applicant also respectfully traverses the rejection.

While Applicant does not acquiesce with the particular rejections to these dependent claims, it is believed that these rejections are moot in view of the remarks made in connection with independent claim 1. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent claims 6-8, and 10-12 are also in condition for allowance.

With respect to claim 49, the Examiner asserts that Jansen teaches cutting the tissue sheet to separate portions of the tissue sheet with a thickness outside of a selected range, wherein the imaging is performed with a laser. See abstract and col. 1,

lines 14-20. The Examiner also asserts that Yamane, et. al. teaches that the cutting is controlled by a process control unit to cut the material to correspond to a target image. See col. 2, line 40 to col.4, line 25. The Examiner contends that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Jansen to utilize a process control method to automatically execute a visual inspection. See Yamane, et al., col. 1, lines 10-20.

Applicant respectfully traverses the rejection.

As noted before, Jansen teaches a method of producing a plastic film having a predefinable outline and/or even or uneven thickness, by machining preformed plastic film for separation and/or ablation. See abstract. The separation or ablation is done by means of a laser beam. See abstract. The synthetic resin surface is locally melted at respective laser burn spots and the melted material vaporized. See col. 2, lines 25-27. This melting and burning is not imaging.

At the same time, Yamane, et. al. does not teach that the cutting is controlled by a process control unit to cut the material to correspond to a target image. See col. 2, line 40 to col.4, line 25. Instead, Yamane, et. al. teaches an image processing inspection apparatus for industrial use in judging the quality of products. See col. 1, lines 5-9. The apparatus has a plurality of image-processing-use image memories to store image data for use in an inspection. See col. 2, line 43-55. The apparatus may store the image data into one image-processing-use image memory and simultaneously execute an inspection process using another image-processing-use image memory in which the image data in the preceding time has been stored. See col. 3, lines 39-45. This is a method for quality inspection.

Claim 49, on the other hand, involves a method of cutting a tissue sheet to remove portions of the tissue sheet having different thicknesses. There is no motivation in Jansen to modify its teaching in the manner suggested by the Examiner to arrive at the subject matter of claim 49. The missing motivation is only supplied by Applicant's invention. As noted above, this is hindsight reconstruction. Therefore, claim 49 is also not obvious over Jansen in view of Yamane, et. al. because the Examiner has failed to make out a prima facie case of obviousness.

Applicant respectfully requests withdrawal of the rejection of claims 1, 6-8, 10-12, and 49 under 35 U.S.C. § 103(a) as being unpatentable over Jansen in view of Yamane, et al.

In view of the amendments and reasons provided above, it is believed that all pending claims are in condition for allowance. Applicant respectfully requests favorable reconsideration and early allowance of all pending claims.

If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicant's attorney of record, Hallie A. Finucane at (952) 253-4134.

Respectfully submitted,

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